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REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed May 3, 2006. Through this response, claims 1, 5, 12, 21-22, 26, 33, and 42 have been amended. Claims 1-42 remain pending. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Double Patenting Rejections – Same Invention Type Double Patenting

Claims 18, 39 have been objected to under 37 CFR 1.75 as allegedly being a substantial duplicate of claims 19, 40. According to the Office Action (page 2), when "two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim." Applicants respectfully traverse this objection, particularly because there has been no indication by the Office Action of an allowed claim.

Further, the section of the MPEP cited in the Office Action (MPEP 706.03(k) further provides the following (emphasis added):

> Inasmuch as a patent is supposed to be limited to only one invention or, at most, several closely related indivisible inventions, limiting an application to a single claim, or a single claim to each of the related inventions might appear to be logical as well as convenient. However, court decisions have confirmed applicant's right to restate (i.e., by plural claiming) the invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough.

Applicants respectfully submit that claims 18 and 19 are of differing scope, as are claims 39 and 40. For instance, claims 18 and 39 refer to media content instances received at a digital

port from a "local network," whereas claims 19 and 40 refer to content received at a digital port from a "local device." As an illustration of a difference, receiving content over a coax-type cable from a subscriber network (*e.g.*, BNC connector) may entail a different type of port than receiving content over a USB connection (e.g., in the case of a local device, such as local DVD player). Thus, since there exists a difference in scope in claims 18, 19 and 39, 40 that entitles the Applicants to these claims, Applicants respectfully request withdrawal of the objection.

II. Claim Rejections - 35 U.S.C. § 102(b)

A. Statement of the Rejection

Claims 1-4, 9, 20, 22-25, 30 and 41 have been rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by *Unger* ("*Unger*," U.S. Pat. No. 6,985,669). Applicants respectfully wish to point out that the rejection has been levied under improper grounds, since to fall under 35 U.S.C. 102(b), the issue date must be more than one year prior to the effective filing date of the application. In this case, the issue date of *Unger* is January 10, 2006, which is after the effective filing date of December 6, 2001. Applicants will treat the rejection as if under 35 U.S.C. § 102(e). Applicants believe the rejection to be rendered moot in view of amendments to independent claims 1 and 22.

B. Discussion of the Rejection

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore,

every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

Although Applicants believe the rejection to be rendered moot in view of the amendments to claims 1 and 22, Applicants address the patentability of the amended claims in view of the *Unger* reference.

Independent Claim 1

Claim 1 recites (with emphasis added):

> 1. A media content recording system in a subscriber television system, comprising:
> a memory for storing logic;
> a buffer space for buffering a plurality of media content instances; and
> a processor configured with the logic to designate as permanent only a media content instance among the plurality of media content instances in the buffer space that is requested by a user for permanent recording, ***the processor configured with the logic to designate as permanent through configuration of a status flag of a management file corresponding to the media content instance.***

Applicants respectfully submit that *Unger* fails to disclose, teach, or suggest at least the features of a ***processor configured with the logic to designate as permanent through configuration of a status flag of a management file corresponding to the media content instance***. For instance, there is no teaching or suggestion of a ***management file*** in *Unger*, and thus Applicants respectfully submit that independent claim 1 is allowable over *Unger*.

Because independent claim 1 is allowable over *Unger*, dependent claims 2-20 are allowable as a matter of law for at least the reason that the dependent claims 2-20 contain all elements of their respective base claim. See, *e.g.*, *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Independent Claim 22

Claim 22 recites (with emphasis added):

> 22. A media content recording method in a subscriber television system, comprising the steps of:
>
> buffering a plurality of media content instances into a buffer space; and
>
> designating as permanent only a media content instance among the plurality of media content instances in the buffer space that is requested by a user for permanent recording, ***wherein designating comprises configuring a status flag of a management file corresponding to the media content instance.***

For similar reasons presented above in association with independent claim 1, Applicants respectfully submit that *Unger* fails to disclose, teach, or suggest at least the features of ***wherein designating comprises configuring a status flag of a management file corresponding to the media content instance.*** Thus, Applicants respectfully submit that independent claim 22 is allowable over *Unger*.

Because independent claim 22 is allowable over *Unger*, dependent claims 23-41 are allowable as a matter of law.

III. Claim Rejections - 35 U.S.C. § 103(a)

A. Statement of the Rejection

Claims 5, 6, 13, 26, 27 and 34 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Unger* in view of *Moon et al.* ("*Moon*," U.S. Pat. No. 6,211,858). Claims 10 and 31 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Unger* in view of *Doherty et al.* ("*Doherty*," U.S. Pat. No. 6,920,567). Claims 7, 8, 11, 12, 28, 29, 32 and 33 have been rejected under 35 U.S.C. § 103(a) as

allegedly unpatentable over *Unger* in view of *Sullivan* ("*Sullivan*," U.S. Pat. No. 6,59 ,421). Claims 14-19 and 35-40 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Unger* in view of *Riffee* ("*Riffee*," U.S. Pat. No. 5,675,375). Claims 21 and 42 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Unger* in view of *Sullivan*, *Riffee*, *Moon*, and *Doherty*. Applicants believe the rejections to claims directly or indirectly dependent on claims 1 and 22 to be rendered moot in view of the amendments to independent claims 1 and 22, and respectfully traverse the rejections to claims 21 and 42.

B. Discussion of the Rejection

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, it is respectfully submitted that a *prima facie* case of obviousness has not been established for the claims, as detailed further below.

Claims 5, 6, 13, 26, 27 and 34

As described above, Applicants respectfully submit that *Unger* fails to disclose, teach, or suggest at least the features of a ***processor configured with the logic to designate as permanent through configuration of a status flag of a management file corresponding to the media content instance***, as recited in independent claim 1, or ***wherein designating comprises configuring a status flag of a management file corresponding to the media content instance***, as recited in independent 22. *Moon* fails to remedy these deficiencies. For example, *Moon* fails to disclose, teach, or suggest a ***management file***. Since dependent claims 5, 6, and 13 and dependent claims 26, 27, and 34 incorporate these same features found in independent claims 1 and 22, respectively, Applicants respectfully submit that claims 5, 6, 13, 26, 27, and 34 are allowable over *Unger* in view of *Moon*.

Applicants also respectfully submit that the proposed combination of *Unger* and *Moon* is not obvious. For instance, the Field of Invention sections of *Unger* and *Moon* provide as follows:

> [Unger]The present invention relates to the field of broadcast data signals, particularly television signals whether broadcast over-the-air, by cable network, satellite system or some other means. More specifically, the present application relates to a method and system of electronically capturing and recording for later retrieval specified segments of the television signal.
> [Moon]The present invention relates generally to mobile communications equipment and is particularly directed to a cellular telephone of the type which includes a computer-controlled graphics display. The invention is specifically disclosed as a portable intelligent communications device that

> has a touch screen display in which the graphics user interface displays a switching meter icon at a given area on the display, and the switching or "rotating" meter displays various symbols that each represent information related to system performance of the portable intelligent communications device.

Applicants respectfully submit that it would not be obvious to one having ordinary skill in the art to combine such disparate systems addressing distinct problems. For example, there is no mention of television systems in *Moon*.

Claims 10 and 31

As described above, Applicants respectfully submit that *Unger* fails to disclose, teach, or suggest at least the features of a ***processor configured with the logic to designate as permanent through configuration of a status flag of a management file corresponding to the media content instance***, as recited in independent claim 1, or ***wherein designating comprises configuring a status flag of a management file corresponding to the media content instance***, as recited in independent 22. *Doherty* fails to remedy these deficiencies. Since dependent claims 10 and 31 incorporate these same features found in independent claims 1 and 22, Applicants respectfully submit that claims 10 and 31 are allowable over *Unger* in view of *Doherty*.

Applicants also respectfully submit that the proposed combination of *Unger* and *Doherty* is not obvious. For instance, the Field of Invention sections of *Doherty* provides as follows:

> The present invention relates to a method and apparatus for controlling the use of files containing digital content, such as computer programs and data and digitally formatted audio and image information, and, more specifically, for a system and license control mechanism for use in creating and distributing files containing digital content and for enforcing the licensed use of digital content files.

Applicants respectfully submit that it would not be obvious to one having ordinary skill in the art to combine such disparate systems addressing distinct problems. For example, there is no mention of television systems in *Doherty*.

Claims 7, 8, 11, 12, 28, 29, 32 and 33

As described above, Applicants respectfully submit that *Unger* fails to disclose, teach, or suggest at least the features of a ***processor configured with the logic to designate as permanent through configuration of a status flag of a management file corresponding to the media content instance***, as recited in independent claim 1, or ***wherein designating comprises configuring a status flag of a management file corresponding to the media content instance***, as recited in independent 22. *Sullivan* fails to remedy these deficiencies. Since dependent claims 7, 8, 11, and 12 and 28, 29, 32 and 33 incorporate these same features found in independent claims 1 and 22, Applicants respectfully submit that claims 7, 8, 11, 12, 28, 29, 32 and 33 are allowable over *Unger* in view of *Sullivan*.

Claims 14-19 and 35-40

As described above, Applicants respectfully submit that *Unger* fails to disclose, teach, or suggest at least the features of a ***processor configured with the logic to designate as permanent through configuration of a status flag of a management file corresponding to the media content instance***, as recited in independent claim 1, or ***wherein designating comprises configuring a status flag of a management file corresponding to the media content instance***, as recited in independent 22. *Riffee* fails to remedy these deficiencies. Since dependent claims 14-19 and 35-40 incorporate these same

features found in independent claims 1 and 22, Applicants respectfully submit that claims 14-19 and 35-40 are allowable over *Unger* in view of *Riffee*.

Claims 21 and 42

In addition to any mention of a management file, Applicants respectfully submit that *Unger* fails to disclose, teach, or suggest at least ***a processor configured with the logic to provide a user interface, responsive to input from the user, that segregates the media content instances of the buffer space into separately identifiable media content instances and enables the user to select and permanently record at least one of the media content instances***," as recited in independent claim 21 and ***providing a user interface, responsive to input from the user, that segregates the media content instances of the buffer space into separately identifiable media content instances and enables the user to select and permanently record at least one of the media content instances***, as recited in independent claim 42. The Office Action refers to Figure 1 and col. 3, lines 10-17 and col. 4, lines 27-31 for alleged support in Unger of the above-emphasized claim features. Applicants respectfully note that there is no mention of a user interface in these sections, and in particular, no user interface for content stored in the buffer space. *Sullivan*, *Riffee*, *Moon*, and *Doherty* fail to remedy these deficiencies. Thus, Applicants respectfully submit that claims 21 and 42 are allowable over *Unger* in view of *Sullivan*, *Riffee*, *Moon*, or *Doherty*.

Additionally, as explained above, Applicants respectfully submit that the proposed combination of *Unger* and *Moon* and *Unger* and *Doherty* are not obvious

In summary, it is Applicants' position that each of these claims is patentable over the art of record.

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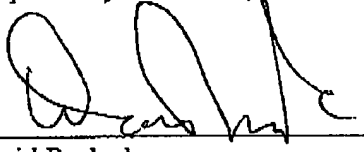
CONCLUSION

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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